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10/057,640	07/23/2002	James Egbert	72854	5169

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CHICAGO, IL 60603-3406

EXAMINER
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CADUGAN, ERICA E

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 11/26/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/057,640

Applicant(s)

EGBERT, JAMES

Examiner

Erica E Cadugan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8-20 and 41-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-20 and 41-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Reissue Application***

#### ***Continuing Obligation***

1. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b) to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,759,140 or RE37794 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56 to timely apprise the Office of any information which is material to the patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP sections 1404, 1442.01, and 1442.04.

#### ***Reference to Parent Application***

2. The transmittal letter filed with the application indicates that the present application is a continuation of 09/586,317, filed on 6/2/2000. However, the first sentence of the present specification has not been amended in accordance with 37 CFR 1.177 which states:

The Office may reissue a patent as multiple reissue patents. If applicant files more than one application for the reissue of a single patent, each such application must contain or be amended to contain in the first sentence of the specification a notice stating that more than one reissue application has been filed and identifying each of the reissue applications by relationship, application number and filing date.

Appropriate correction is required. Note that the following office action is generated on the assumption that Applicant will fulfill the afore-stated requirements of making the present application a proper continuation, and that if Applicant does *not* fulfill these requirements, that

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different issues may arise, such as, for example, there would be a different effective filing date of the present application which could affect the patentability of the claims over the prior art.

***Oath/Declaration***

3. The supplemental reissue oath/declaration filed 10/23/2003 with this application is defective because the error which is relied upon to support the reissue application is not an error upon which this reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Note specifically that the error relied upon relates to claim language in claim 1 that Applicant asserts sets forth “less than I had a right to claim in the patent”. However, claim 1 was canceled by the amendment filed 10/23/2003, as was claim 21 which incorporated changes to the language mentioned regarding claim 1, leaving claims 8-20 and 41-46 as the only claims present in the case. However, claims 8-20 are identical to how they appeared in the patented case, and claims 41-46 are identical in scope to how claims 2-7 appeared in the patented case (claims 41 and 43-46 are merely patented claims 2 and 4-7 rewritten in independent form, and claim 42 corresponds to patented claim 3). Thus, there is no identified error to any pending claim, nor is there any corresponding corrective action that has been taken, since the only claims remaining in the case are claims with limitations as they were set forth in the patented case.

Note that per 37 CFR 1.177(c), “no reissue application containing only unamended patent claims and not correcting an error in the original patent will be passed to issue by itself”.

4. Claims 8-20 and 41-46 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Note that assuming Applicant is able to overcome the aforementioned rejection, in accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed, including language such as the following exemplary language:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

### ***Double Patenting***

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

See MPEP section 1451 for specific discussion of double-patenting in a Reissue application with respect to a parent case.

6. Claims 9-14, 16, 18-20, 45, and 46 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 9-14, 16, 18-20, 6, and 7, respectively of prior U.S. Patent No. RE37,794. This is a double patenting rejection.

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7. Note that claims 9-14, 16, and 18-20 of the present application are the same as those claims of the same number of '794. Also, note that present claims 45 and 46 contain the same limitations as claims 6 and 7, respectively, of '794.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claim 8 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of U.S. Patent No. RE 37794. Although the conflicting claims are not identical, they are not patentably distinct from each other because. The more specific claim 10 of '794 anticipates the broader present claim 8. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

***Claim Rejections - 35 USC § 102***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 11, 41, and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,058,261 (Kitamura).

Kitamura teaches an apparatus for machining holes in a workpiece. A “frame” is provided and a workhead 4 supports a workpiece chuck 40 that is “driven” and supports a workpiece for rotation about a “rotational axis to present different circumferential positions for machining of holes” in the workpiece. The workhead 4 and workpiece carried thereon is further supported upon driven indexing means 6 to shift the workpiece “so that holes may be machined at various angles relative to the rotational axis”. A “machine head” or toolhead 5 is provided with a machining tool for making holes. Not that the use of a drill for machining holes is illustrated in the Figure 8 embodiment. This toolhead may be movable along a “plunging axis”, or z axis in Kitamura’s machine tool arrangement. This is set forth in Kitamura in an embodiment not shown but contemplated at column 4, lines 32-35. Applicant’s operation upon a “crankshaft” as the selected workpiece is noted, but the workpiece is not considered to be limiting of the apparatus claimed. See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969): “[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim”. Furthermore, “[i]nclusion of material or article worked on by a structure being claimed does not impart patentability to the claims.” *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

Specifically regarding claim 11, note that the vertical face (as viewed in Figure 1) of the workholder 20 into which the workpiece W is inserted has an opening (into which the workpiece is inserted). Also note that that this face would “allow loading and unloading of a crankshaft when the workholder is tilted to a crankshaft loading position”.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 8-9, 13-15, 17-19, 42, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,058,261 (Kitamura) as applied above.

Kitamura teaches all aspects of the claimed invention as described in the above rejection based thereon, but Kitamura teaches movement of the workpiece along various one/ones of the three orthogonal axes and movement of the toolhead along the remaining of the three axes instead of teaching movement of all three axes by the toolhead relative to a stationary workpiece, and additionally, Kitamura teaches only a single toolhead and a single workholder (see Figure 1) rather than the plural ones claimed. Additionally, regarding claims 13-14, Kitamura explicitly teaches a generic tool changer 102 and tool storage magazine 104 (see Figure 5), but is silent as to the particular structure thereof. Additionally, regarding claims 15, 17, 18, and 19, while for the apparatus claims, Kitamura is considered to apply regardless of the specific teachings of the type of workpiece as described above, for the method claims, Kitamura does not specify that the workpiece is a crankshaft.



Regarding the axes of movement, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have provided the required relative XYZ movement only in the machine tool head as a choice of design as it is well-known in the machine tool art that such relative movement may be achieved either by movement of tool, and because Applicant has not disclosed that using the a tool head moveable along three orthogonal axes (as opposed to creating this relative three-axis orthogonal movement via other types of relative movement between the tool and workpiece such as movement of the workpiece alone or a combination of tool and work movement) provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the movement taught by Kitamura because it doesn't affect the outcome, i.e., the produced workpiece is the same, whether or not the relative movement is a result of all tool movement in the three directions or is a result of movement of the tool in some of the three directions and movement of the workpiece in the remainder of the three directions.

Therefore, it would have been an obvious matter of design choice to modify Kitamura to obtain the invention as specified in the claims.

Additionally, regarding the plural tool heads and plural work holders, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided as many tool heads and work holders as were desired or expedient, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding the particular tool changer, Examiner takes Official Notice that the use of an automatic tool changing device that is “movable from a remote position to a tool changing position” between the “workholder” and the “machine head” and also where on the frame there are “means” to “guide the automatic tool changer to slide laterally” into a position between a workholder and a toolhead are well-known in the machine tool art. Specifically note that in the U.S. Patent classification system, class 483 is directed to automatic tool changing devices and that a good number of the devices in this class fall into the category set forth in claims 13-14. Therefore, absent any criticality, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected a well-known tool changer of the type set forth in the claims and to have substituted such a particular tool changer for the generically-described one taught by Kitamura as a design choice of the end user depending upon many factors such as availability of a particular changer at the time of design, or cost, for example.

Regarding the method claims and the particular workpiece therein, one of ordinary skill in the machine tool art would be expected to operate upon known workpieces, such as a “crankshaft” as the claimed method of use and the apparatus taught by Kitamura would be applicable to any generally rotationally symmetrical shaft-like workpiece, and as such, the selection of such a crankshaft for a workpiece for Kitamura’s invention would be a choice of design of the end user of Kitamura’s invention.

14. Claim 10 and 43-44, and alternatively, claims 15 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,058,261 (Kitamura) in view of Hakayama et al. (JP-59-232707).

Kitamura teaches all aspects of the claimed invention as described in the above rejections based thereon, and additionally, regarding claim 10, note that no frame of reference is set forth in the claims for determining the direction of the “horizontal axis” of the trunnions except that it must be provided so that the workpieces are presented by the fixture “at various tilt angles to the plunging axis”. It is noted that the axis about which the work “tilts” (via movement in direction B) is shown in Figure 1 as a vertical axis, but that if Figure 1 is rotated 90 degrees clockwise, a frame of reference is provided in the Figure such that this axis is horizontal, and note that the workpiece is still being tilted at “various angles to the plunging axis (Figures 1 and 8, for example). Regarding method claims 15 and 17-19, Kitamura does not specify a crankshaft workpiece.

Kitamura teaches movement of the workpiece along various one/ones of the three orthogonal axes and movement of the toolhead along the remaining of the three axes instead of teaching movement of all three axes by the toolhead relative to a stationary workpiece, and additionally, Kitamura teaches only a single toolhead and a single workholder (see Figure 1) rather than the plural ones claimed, and also, while Kitamura does generically teach the use of an automatic tool changer 102 and tool storage magazine 104 (see Figure 5, for example), Kitamura does not teach the use of “tool support bushings” that are exchanged thereby.

Regarding the axes of movement, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to

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have provided the required relative XYZ movement only in the machine tool head as a choice of design as it is well-known in the machine tool art that such relative movement may be achieved either by movement of tool, and because Applicant has not disclosed that using the a tool head moveable along three orthogonal axes (as opposed to creating this relative three-axis orthogonal movement via other types of relative movement between the tool and workpiece such as movement of the workpiece alone or a combination of tool and work movement) provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the movement taught by Kitamura because it doesn't affect the outcome, i.e., the produced workpiece is the same, whether or not the relative movement is a result of all tool movement in the three directions or is a result of movement of the tool in some of the three directions and movement of the workpiece in the remainder of the three directions.

Therefore, it would have been an obvious matter of design choice to modify Kitamura to obtain the invention as specified in the claims.

Additionally, regarding the plural tool heads and plural work holders, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided as many tool heads and work holders as were desired or expedient, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding the tool support bushings, while Kitamura does not teach the use of a "tool support bushing", such means are well-known and taught by Hayakawa et al. (see Figure 1), and

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one possessing ordinary skill in the machine tool art would be expected to utilize such means to obtain the expected benefits, for example, of reduced run-out and increased machining accuracy that would accrue thereto. Again, note that the use of tool storage and changing means are common and explicit in Kitamura (see Figure 5).

In the alternative regarding the specific workpiece, note that Hayakawa teaches the drilling of oil holes at angles to the plunging axis and to the longitudinal crankshaft axis within a crankshaft (see Figures).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted the particular crankshaft workpiece taught by Hayakawa et al. for the generic workpiece taught by Kitamura for the purpose of expanding the market for Kitamura's device by providing a particular industry that desires to drill holes at the varied angles taught by Hayakawa.

In the alternative regarding the "horizontal" trunnion axis described above, one of ordinary skill in the art would be expected to arrange the machine taught by Kitamura in whatever way was desired or expedient such that the trunnion axis was arranged either horizontally or vertically, for the purpose, for example, of arranging the device in what ever way best fit the available space of the facility where the machine was to be installed, particularly since both vertical and horizontal axes tools are well-known in the art.

### ***Conclusion***

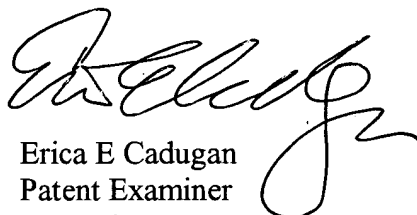
15. The art made of record and not relied upon is considered pertinent to applicant's disclosure.

***Faxing of Responses to Office Actions and Contact Information***

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16. In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703) 872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica Cadugan whose telephone number is (703) 308-6395. The examiner can normally be reached on Monday through Thursday from 7:30 a.m. to 5:00 p.m., and every other Friday from 7:30 a.m. to 4:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A.L. Wellington can be reached at (703) 308-2159. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703) 308-1148.

  
Erica E Cadugan  
Patent Examiner  
Art Unit 3722

eec

November 18, 2003